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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,606	06/03/2005	Masato Yoshioka	4244-0106PUS1	3568
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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER FISHER, ABIGAIL L	
			ART UNIT 1609	PAPER NUMBER
			NOTIFICATION DATE 09/18/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/537,606

Applicant(s)

YOSHIOKA ET AL.

Examiner

Abigail Fisher

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1 sheet.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claims 1-5 are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement filed June 3 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

Claims 1 and 2 are objected to because of the following informalities: N-glyceryl is misspelled as N-glyoeryl. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1609

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 as written is vague and indefinite. By use of the word represented it is unclear whether formula I is the content of the cosmetic or whether analogs or derivatives of formula I are also being claimed as content of the cosmetics.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (Japanese Patent Application No. 20000190723, published January 9

Art Unit: 1609

2002) in view of Yokoi et al. (Japanese Patent No. 11322688, published on November 24 1999).

For claims 1-3: Kobayashi et al. describes a permanent wave-treating agent composition. This composition consists of an arginine derivative. When this compound is compared to formula I of the instant application (claim 1), the requirement for X is met (X is H), Y is met (side of arginine is presented), and Z is met (Z is H) (see chemical formula 1 of claim 1 in Kobayashi et al.). Arginine is a basic amino acid, a requirement of claim 3 of the instant application. The composition containing the arginine compound contains the arginine compound from 0.01 to 50 weight % which suggests the species of claim 2 of the instant application. However the arginine compound of Kobayashi et al. contains an alkyl group attached to the glyceryl derivative.

Yokoi et al. describes N-acylamino acids that can be used as detergents, examples include shampoo, body shampoo, and hand soap (paragraph 0009). The precursor to these N-acylamino acids is a compound of chemical formula 2. When this compound is compared to formula I of the instant application, the requirement for X is met (X is H), Y is met (side chain of glycine is presented), and Z is met (Z is H). These compounds additionally possess the N-glyceryl derivative of formula I of claim 1 of the instant application. Yokoi et al. discloses that the N-acylamino acids are mild on the skin and have excellent stability in hard water (paragraph 0004). Yokoi et al. additionally discloses that the N-acylamino acids that contain a dihydroxy propyl group are quite effective surface-active agents and leave a good feel on the skin (paragraph 0004).

Art Unit: 1609

For claims 4-5: Application of N-acylamino acid compositions of Yokoi et al. is disclosed as being applicable in shampoos, a body shampoo, or a hand soap.

Therefore the requirement of claim 4 of the instant application in which the cosmetics are skin care cosmetics and that of claim 5 of the instant application in which the cosmetics are hair cosmetics have been met.

Replacement of the alkyl group of Kobayashi et al. would have been obvious in view of Yokoi et al. because Yokoi et al. discloses that the compounds with a dihydroxy propyl group are effective surface-active agents and leave a good feel on the skin. Therefore one skilled in the art would have been motivated to modify the compound of formula 1 of Kobayashi with the dihydroxyl propyl group of Yokoi et al. in the attempts to make a cosmetic that would be likely to leave a good feel on the skin.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice of Kobayashi et al. but with the dihydroxy propyl group of Yokoi et al. thus resulting in the practice of the instantly claimed invention with a reasonable expectation of success.

Conclusion

No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail Fisher whose telephone number is 571-270-3502. The examiner can normally be reached on M-Th 9am-4pm EST.

Art Unit: 1609

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718 or Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AF


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